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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/508,861

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT

PAPER NUMBER

1794

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/508,861	<b>Applicant(s)</b> KOBAYASHI ET AL.	
	<b>Examiner</b> Marie R. Yamnitzky	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-9 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

1. This Office action is in response to applicant's amendment filed April 22, 2008, which cancels claim 1 and amends claims 2, 4, 7-9 and 16-20. (Although claims 8 and 16-20 are not marked as amended claims in the amendment filed April 22, 2008, the claim dependency of each of these claims has been changed relative to the most recently entered prior version of the claims. Also, the changes to claim dependency in amended claims 7 and 9 are not shown relative to the most recent prior version of the claims. The preliminary amendment filed September 24, 2004 amended each of claims 7-9 to depend solely from claim 2, and amended each of claims 16-20 to depend solely from claim 10.)

This Office action is also in response to the certified translations filed April 22, 2008 of applicant's foreign priority applications: JP 2002-86173 and JP 2002-86174.

Claims 2-20 are pending.

2. The rejection of claims 1, 2 and 4-9 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as set forth in the Office action mailed October 22, 2007, is partly rendered moot by claim cancellation and otherwise overcome by claim amendment.

The rejection of claims 1, 2, 8 and 9 under 35 U.S.C. 102(b) as anticipated by Robinson et al. (*Chem. Commun.* 2000, pp. 1645-1646) as set forth in the October 22<sup>nd</sup> action is partly rendered moot by claim cancellation and otherwise overcome by claim amendment.

The rejection of claims 1, 2 and 5-9 under 35 U.S.C. 102(e) as anticipated by Kamatani et al. (US 6,953,628 B2) as set forth in the October 22<sup>nd</sup> action is partly rendered moot by claim cancellation and otherwise overcome by claim amendment.

The rejection of claim 1 under 35 U.S.C. 102(e) as anticipated by Lo et al. (US 2005/0116622 A1) as set forth in the October 22<sup>nd</sup> action is rendered moot by claim cancellation. (The rejection of claims 2 and 4-9 as anticipated by Lo et al. is maintained. In light of the certified translations of applicant's foreign priority applications, it is the examiner's position that the disclosure of Lo et al. remains available as prior art against previously rejected claims 2 and 4-9. Further explanation is provided later in this action.)

3. Claims 3 and 10-20 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 24, 2007.

4. Claims 7-9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Claim 7 presently depends from "any one of claims 2 to 6", but claims 5 and 6 are multiple dependent claims. Claims 8 and 9 presently depend from "any one of claims 2 to 7", but claims 5-7 are multiple dependent claims. For purposes of further examination, claims 7-9 are treated as if dependent solely from claim 2.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 2 and 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Lo et al. (US 2005/0116622 A1).

The 102(e) date for this reference is March 18, 2003.

Lo et al. provide a specific example of an iridium complex represented by formula (3) as defined in present claim 2 wherein  $L^1$  is a ligand represented by present formula (5) wherein  $Ar^2$  is a bidentate ligand represented by formula (6) as defined in present claim 7 and D is a divalent group derived from conjugate system. See formula 7 in Figure 4, and Examples 12, 16 and 17 (pages 9-11). The complex of Example 12 meets the limitations of a complex as claimed in present claims 2 and 4-8 wherein D is a divalent group derived from conjugate system, and is disclosed for use in an organic electroluminescent device of the structure set forth in present claim 9.

7. Applicant's arguments filed April 22, 2008 have been fully considered but they are not persuasive with respect to the patentability of claims 2 and 4-9 over Lo et al.

Applicant argues that given the verified English translations of applicant's priority documents, Lo does not constitute prior art. The examiner has considered the verified English translations and respectfully disagrees.

Priority document JP-2002-086174 is limited to polymeric embodiments (a polymeric light emitting substance having a metal complex structure in the main chain or side chain) and does not support the rejected claims, which require a complex represented by formula (3) as defined in present claim 2.

Priority document JP-2002-086173 discloses some species within the scope of the rejected claims, but does not disclose the species disclosed by Lo et al. and does not fully support the terminology of present claim 2 with respect to the embodiment anticipated by Lo et al. Lo et al. was/is applied to the embodiment wherein present  $L^1$  represents a ligand represented by formula (5). Formula (5) contains the variable “D”, which is defined in present claim 2 as “a divalent group derived from conjugate system”. The examiner does not find the formula containing variable “D” in the ‘173 priority application, nor does the examiner find the phrase “divalent group derived from conjugate system” in the ‘173 application. The ligand represented by present formula (5) is similar to, but not of the same scope as, the ligand of formula (3) of the ‘173 priority document. In place of the variable “D” of present formula (5), formula (3) of the ‘173 priority document contains the variables  $(Ar_3)_c$ .  $Ar_3$  represents a group selected from an alkylene group, arylene group and divalent heterocyclic group, and c represents 0 or 1. The ‘173 priority document also provides some examples of  $Ar_3$ . While the definition of  $Ar_3$  provides some overlap with the definition of present D, the definition of  $Ar_3$  is not commensurate in scope with the definition of D, and it is the examiner’s position that the examples of  $Ar_3$  that are provided in the ‘173 priority document do not provide sufficient support for the full scope of present D as a “divalent group derived from conjugate system”.

8. With respect to applicant's remarks regarding the Information Disclosure Statement filed September 24, 2004, applicant's attention is respectfully directed to MPEP 609.03, 609.04(a) and 609.04(b). The examiner is not required to consider the cited documents when copies of the documents are not present in the national stage file. However, as noted in the Office action mailed October 22, 2007, the examiner did consider and make of record US equivalents of the two cited foreign patent documents. The examiner also considered and made of record one of the five non-patent literature documents listed in the IDS (listing the document on a PTO-892).

If applicant wants the two foreign patent documents to be considered and made of record (in addition to the US equivalents previously considered and made of record by the examiner) and/or wants the remaining four cited non-patent literature documents to be considered and made of record, applicant must provide copies of the documents to be considered. Note that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP 609.05(a).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

/Marie R. Yamnitzky/  
Primary Examiner, Art Unit 1794

MRY  
July 20, 2008